

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of	:	Xin Jin, <i>et al.</i>
	:	
Application No.	:	10/679,575
	:	
Filed	:	October 6, 2003
	:	
Title	:	System and Method of Controlling Transmit
	:	Power for Mobile Wireless Devices With
	:	Multi-Mode Operation of Antenna
	:	
Examiner	:	Tilahun Gesesse
	:	
TC/A.U.	:	2618
	:	
Docket No.	:	555255-012590

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the final Office Action mailed on June 2, 2010 and pursuant to the Notice of Appeal filed on September 17, 2010 and in further response to the Notice of Panel Decision from Pre-Appeal Brief Review issued on September 24, 2010. Any fees due may be withdrawn from Jones Day Deposit Account No. 501432, ref. 555255-012590.

(I) REAL PARTY INTEREST

The real party in interest is Research In Motion Limited, having its principal place of business at 295 Phillip Street, Waterloo, Ontario, CANADA N2L 3W8, as evidenced by an assignment executed February 18, 2004 and recorded under Reel/Frame 015410/0775.

(II) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this application.

(III) STATUS OF CLAIMS

Claims 54 – 57 are pending and have been finally rejected. Claims 1 – 53 and 58 – 61 are cancelled. Claims 62-65 have been subjected to a restriction requirement and claim 54 was objected to, in part. Claims 54-57 and 62-65 are being appealed.

(IV) STATUS OF AMENDMENTS

An amendment was filed subsequent to the final rejection to amend claim 1. A subsequent advisory action was issued by the Examiner on September 8, 2010, advising that the amendment would not be entered.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 54

Independent claim 54 is directed to an apparatus comprising a wireless telephone configured to automatically adjust the power level of its output signal based on whether the wireless telephone is in speakerphone mode. An example implementation of this claim element is described in the specification at page 7, lines 5 – 23.

The apparatus is further configured to increase the power level when the wireless telephone is in speaker mode. An example implementation of this claim element is described in the specification at page 7, lines 5 – 23.

B. Independent Claim 62

Independent claim 62 is directed to a method of controlling a transmit power configuration for a wireless communication device. An example implementation of this claim element is described at page 7, lines 5 – 23.

The method further includes the step of using a first transmit power setting for the transmit power configuration upon initiation of a wireless communication. An example implementation of this claim element is described at page 7, lines 5 – 23.

The method further includes the step of detecting that the wireless communication device enters a speakerphone mode during a wireless communication. An example implementation of this claim element is described at page 7, lines 5 – 23.

The method further includes the step of automatically switching the transmit power

configuration to a second transmit power setting if the wireless communication device enters the speakerphone mode during a wireless communication. An example implementation of this claim element is described at page 7, lines 5 – 23.

(VI) GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

Claims 54 - 57 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,039,435 (hereinafter referred to as “McDowell Reference” or “McDowell”). Claims 62 – 65 were withdrawn from consideration as being directed to a non-elected invention. These rejections are appealed.

An amendment to independent claim 54 was objected to for not specifically providing support from the specification. This objection is traversed below.

(VII) ARGUMENT

A. Restriction Requirement

Claims 62 – 65 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. The withdrawal of claims 62 – 65 is improper because independent claim 62 is drawn to the same subject matter of independent claim 54.

The method of claim 62 recites detecting a first power setting, detecting a speakerphone mode, and upon detecting the speakerphone mode, automatically switching the power configuration to a second power setting. Similarly, independent claim 54 recites an apparatus “configured to automatically adjust the power level of its output signal based on whether the wireless telephone is in speakerphone mode.” Therefore, claim 62 is merely the apparatus of claim 54 written as a method claim.

A proper restriction requirement contains two parts: (1) the reasons why each invention as claimed is either independent or distinct from the others, and (2) the reasons why there would be a serious burden on the examiner if restriction is not required. (MPEP § 808). The first part of the restriction requirement requires the examiner to concisely state “the particular reasons relied upon...for holding that the inventions as claimed are either independent or distinct.” Notably, “[a] mere statement of conclusion is inadequate.” The second part of the restriction requirement imposes the duty upon the examiner to specifically explain why examining the claims at issue would constitute a serious burden by one of the following reasons:

(A) Separate classification thereof...

(B) A separate status in the art when they are classifiable together...

(C) A different field of search...

(MPEP § 808.02). “Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” *Id.*

The Examiner’s sole reason for the restriction requirement is that the limitations of claim 62 are “not related to a wireless telephone automatically adjust [*sic*] the out put [*sic*] power signal based on the wireless telephone is in speaker mode.” (June 2 Office Action, p. 2). The Examiner has failed to satisfy part one of a proper restriction requirement. A conclusory statement that the claims are not related, with no reasons provided, is the exact situation the MPEP forbids. Accordingly, the restriction requirement is improper for at least this reason.

Even if the Examiner had provided reasons for the restriction requirement, there is no explanation of how the examination of claims 62 – 65 would constitute a “serious burden.” (MPEP § 803). Not only did the Examiner fail to specifically explain how examining claims 62-65 would constitute a serious burden under one of the three categories listed above, but the Examiner failed to provide *any* explanation at all. There is no explanation provided because the examination of claims 62-65 provides absolutely no burden on the Examiner. The claims would require no further search, are in the same classification as the pending claims, and there is no indication of a separate future classification. Accordingly, the Examiner has failed to meet the elements of a proper restriction requirement, and the restriction for claims 62-65 must be withdrawn.

B. Lack of Support

The June 2, 2010 Office Action noted that the amendment to claim 54, reciting “wherein the power level is increased when the wireless telephone is in speakerphone

mode,” lacked support in the specification and the Applicant must provide support in the specification to support the amendment. As noted above, support for this limitation can be found in the specification at least at page 7, lines 18 – 23 (“a wireless device might start with one power configuration, but dynamically changes when then user....switches to speaker phone.”) and at page 7, lines 5 – 11 (“The power controller determines the appropriate power levels...including limiting maximum power and minimum power levels...”). Accordingly, this limitation is properly supported by the specification, and the objection should be withdrawn.

C. Independent claim 54

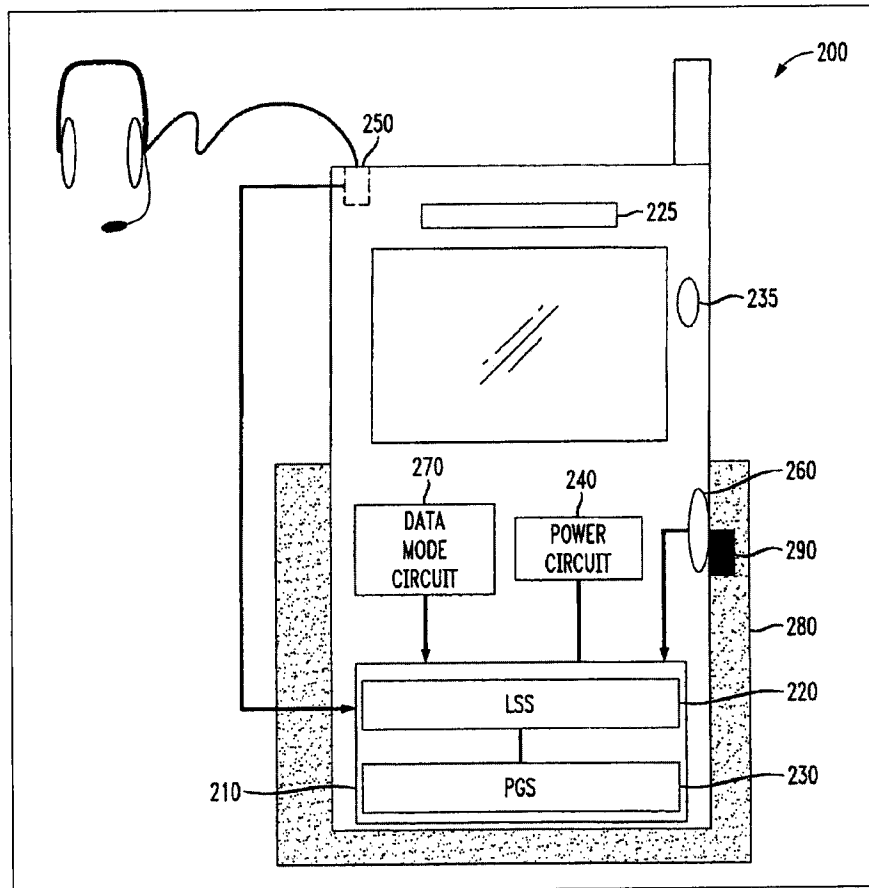
Independent claim 54 generally relates to a wireless telephone configured to automatically adjust the power level of its output signal when the telephone enters a speakerphone mode. Claim 54 was rejected under 35 U.S.C. § 102(e) as anticipated by McDowell based on the Examiner’s incorrect interpretation of “speakerphone mode.” The McDowell reference fails to disclose adjusting the power level when the telephone enters a speakerphone mode, and therefore, the rejection is improper and must be withdrawn.

McDowell is directed to determining a transmit level in a mobile device based on the proximity to a user. (McDowell, col. 1:7-10). The system in McDowell utilizes a location sensing subsystem that is configured to determine the location of the mobile device in relation to a user. (McDowell, col. 2:6-11). Based on the location of the device in relation to the user, a power governing subsystem determines a transmit power of the mobile device. *Id.*

As shown in Fig. 2 of McDowell below, the system includes a proximity regulation

system 210, which can be connected to the headset operation mode input 250. (McDowell, Fig. 2; col. 4:39-45). The proximity regulation system receives an indication that the headset is connected and the mobile phone is not within the vicinity of the user's head. (McDowell, col. 5:51-62). The headset input 250 is a conventional input for receiving a headset that allows for hands-free operation. *Id.*

McDowell Fig. 2



The Office Action cites to various portions of McDowell reciting a “headset” as disclosing the limitation “automatically adjusting the power level...based on whether the

wireless telephone is in speakerphone mode.” In none of the Office Actions, nor the Advisory Action, does the Examiner explain how a speakerphone mode is disclosed or suggested by reference to the “headset” of McDowell. When presented with Applicant’s commonly accepted definition of “speakerphone” the Examiner responded that this definition was “not recited in the rejected claim(s)” and “limitations from the specification are not read into the claims.” (June 2 Office Action, p. 3). The Examiner’s attempt to not give the claim language its ordinary meaning is improper.

The Patent Office must give claims their broadest reasonable interpretation. In doing so, the claims must be given their plain meaning unless this plain meaning is inconsistent with the specification. (MPEP § 2111.01). Here, the term “speakerphone” has a well-established meaning to those of ordinary skill in the art of “equipped with both loudspeaker and microphone.” (*See*, Applicant’s 8/26/10 Response, at p. 6; www.dictionary.com). Furthermore, loudspeaker has a commonly accepted definition of “various devices...by which speech, music, etc., can be intensified and made audible throughout a room, hall, or the like.” *Id.* The specification does not contain any definition of either “speakerphone” or “loudspeaker” that would contradict its ordinary meaning. Therefore, it is clear error for the Examiner to assign any other meaning to this well known term.

Using the plain meaning of the claim language, the McDowell reference fails to teach or suggest adjusting the power level of a mobile device when it enters a speakerphone mode. McDowell merely discloses a “headset,” which is connected to a mobile device and rests against a user’s ear providing sound to *only* that user. In contrast, the present Application provides for a speakerphone mode, which utilizes a loudspeaker in

the mobile device. Clearly, one of skill in the art would not equate the “headset” of McDowell to the “speakerphone” of the present Application because the “headset” of McDowell lacks a loudspeaker and the ability to project sound throughout a room. The “headset” of McDowell, therefore, cannot meet the limitations of claim 54 requiring a speakerphone mode. Because the Office Action has failed to show how McDowell teaches each limitation of independent claim 54, the rejection must be withdrawn.

D. Independent claim 62

Independent claim 62 contains similar limitations to independent claim 54. (*See, supra*, Section VII (A), noting that claims 62-65 are method claims including the same limitations as the apparatus claims of 54-57). Therefore, independent claim 62 is patentably distinct over the cited McDowell reference for at least the reasons discussed above with respect to independent claim 54. Accordingly, independent claim 62 must be allowed.

E. Dependent Claims 55-57 and 63-65

The remaining claims all depend from base claims that are explained above to be patentable over the prior art. The limitations that the dependent claims add to the base claims distinguish them further from the prior art.

(VIII) CLAIMS APPENDIX

A claims appendix containing a copy of the claims subject to this appeal is attached.

(IX) EVIDENCE APPENDIX

No evidence is being submitted pursuant to 37 C.F.R. 1.130, 1.131 or 1.132, nor is there any other evidence entered by the Examiner or relied on by the Applicant. An evidence appendix indicating "None" is attached.

(X) RELATED PROCEEDINGS APPENDIX

There are no proceedings related to this application. A related proceedings appendix indicating "None" is attached.

Respectfully submitted,
JONES DAY



Joseph M. Sauer
(Reg. No. 47,919)

Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7506

CLAIMS APPENDIX

1-53. (Canceled)

54. (Previously Presented) An apparatus comprising:

a wireless telephone configured to automatically adjust the power level of its output signal based on whether the wireless telephone is in speakerphone mode;

wherein the power level is increased when the wireless telephone is in speakerphone mode.

55. (Previously Presented) The apparatus of claim 54, wherein the power level is adjusted during a single communication session.

56. (Previously Presented) The apparatus of claim 54, wherein the power level is adjusted setting a maximum output power level.

57. (Previously Presented) The apparatus of claim 54, wherein the power level is adjusted by setting a minimum transmit power level.

58-61. (Canceled)

62. (Previously Presented) A method for controlling a transmit power configuration for a wireless communication device, comprising:

using a first transmit power setting for the transmit power configuration upon initiation of a wireless communication;

during the wireless communication, detecting that the wireless communication device has entered a speakerphone mode; and

in response to detecting that the wireless communication device has entered the speakerphone mode, automatically switching the transmit power configuration to a second transmit power setting during the wireless communication.

63. (Previously Presented) The method of claim 62, wherein the first transmit power setting is lower than the second transmit power setting.

64. (Previously Presented) The method of claim 63, wherein the first transmit power setting is selected to be within a predetermined transmit power limit for when the wireless communication device is near the user's head.

65. (Previously Presented) The method of claim 64, wherein the second transmit power setting is above the predetermined transmit power limit.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None